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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,970	03/24/2004	Frank Odenthal	10541-1994	4461

57444 7590 09/11/2006

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EXAMINER

KRAUSE, JUSTIN MITCHELL

ART UNIT	PAPER NUMBER
3682	

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/807,970		<b>Applicant(s)</b> ODENTHAL ET AL.	
	<b>Examiner</b> Justin Krause		<b>Art Unit</b> 3682	

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 30 June 2006.

2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-8 and 11 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-8, 11 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
       Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
       Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All    b) ☐ Some    \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ 5) <input type="checkbox"/> Notice of Informal Patent Application 6) <input type="checkbox"/> Other: _____
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## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-8 and 11 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claims 1-18 of

copending Application No. 10/324,841. Although the conflicting claims are not identical,

they are not patentably distinct from each other because both applications disclose a

steering rack mechanism with a nut and plastic retaining ring that is melted into place.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Objections***

3. Claim 1 is objected to because of the following informalities: line 9-10, "the at least on finger and the at least on finger..." appears as if the word "on" should be "one". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 6 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. The phrase "in a way" is indefinite because it is unclear what the meaning of this phrase is for providing any structure that allows the function to occur.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4, 6-7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips (US Patent 5,718,149) in view of Peterkort (US Patent 5,597,278).

Phillips discloses a toothed rack steering gear assembly comprising:

an adjusting nut (80) having external threads;

a housing (10) having portions defining an opening (36) with internal threads (34), the opening adapted to the adjusting nut so as to receive the adjusting nut in an assembled state of the rack steering gear assembly, at least one recess being provided in the housing, the recess being in direct proximity of the opening;

a retainer (82) having a ring shaped body

the retainer further including a back surface and the adjusting nut further including a front surface, in the assembled state the front surface of the adjusting nut being in contact with the back surface of the retainer, the adjusting nut and the retainer being fixedly and securedly connected to each other between the back surface and the front surface in the assembled state of the assembly.

Philips does not disclose the retainer further having at least one finger protruding from the ring shaped body, the finger corresponding to the recess and being located and positioned in the recess, the at least one recess and the at least one finger corresponding in number;

Peterkort teaches a retainer having a finger (58) protruding from a ring shaped body and corresponding to a recess (54), the finger and recess corresponding in number, for the purpose of restraining rotational movement of the retainer (Col 3, line 62).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add a finger to the retainer of Phillips as taught by Peterkort, the motivation would have been to prevent rotation of the retainer relative to the housing.

Regarding claims 2 and 3, the adjusting nut has a drive portion with a multi-point driving head. (see fig 1)

Regarding claim 4, the recess is open in a direction of the internal threads.

Regarding claim 7, in an axial direction the at least one recess extends only over a sub-range of an axial length of the internal threads so that, starting from a front surface of the housing, there is an unimpaired part of the internal thread beyond the at least one recess, and wherein an axial length of the external thread of the adjusting nut is larger than an axial length of the at least one recess.

Regarding claim 11, the retainer and adjusting nut are fixedly connected by connecting devices.

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips in view of Peterkort as applied to claim 1 above, and further in view of Bradley, Jr. (US Patent 4,092,080).

Phillips and Peterkort do not disclose the one finger having an inner surface corresponding with the internal threads and having projections on the inner surface.

Bradley, Jr teaches a retaining ring (21/22) having an inner surface corresponding with the internal threads and having projections on the inner surface thereof for the purpose of providing an anti-rotation lock capable of withstanding increased load limitations (col 1, lines 44-45).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the inner surface of the retainer ring fingers correspond to the internal threads with protrusions, the motivation would have been to provide an anti-rotation lock capable of withstanding increased load limitations.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips in view of Peterkort as applied to claim 1 above, and further in view of Carlton (US Patent 719,745).

Phillips and Peterkort do not disclose a rib.

Carlton teaches a rib (3) on a back surface to form a washer seat for the nut (line 82).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add a rib as taught by Carlton, the motivation would have been to provide a washer seat for the nut.

The limitation regarding the use of ultrasonic welding is a method limitation, and does not impart any additional structure to the device.

***Response to Arguments***

11. Applicant's arguments with respect to claims 1-8 and 11 have been considered but are moot in view of the new ground(s) of rejection.

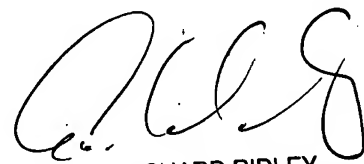
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin Krause whose telephone number is 571-272-3012. The examiner can normally be reached on Monday - Friday, 7:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMK  
9/5/06

  
RICHARD RIDLEY  
SUPERVISORY PATENT EXAMINER